REMARKS

The Examiner has objected to the Amendment of July 17, 2009 as not being fully responsive to the double patenting rejection. The Examiner also stated that it was not proper to respond to a rejection by asking that the rejection be held in abeyance while citing 37CFR§1.111(b).

Reconsideration of the decision holding the Amendment non-responsive is requested.

The provisions of 37 CFR§1.111(b) pertain to rejections and do not refer to provisional double patenting rejections which are not ordinary rejections but are a type of rejection that is handled in a different manner. MPEP §804 points out that the Examiner may make an applicant aware of potential double patenting by permitting the examiner to make a "provisional" double patenting rejection. This provisional rejection does not require an applicant to abandon one of the two involved applications. *Ex parte Feister*, 1890 C.D. 107.

The courts have considered the legal effect of a provisional double patenting rejection and have stated:

> "Once the provisional rejection has been made, there is nothing the examiner and the applicant must do until the other application issues". *In re Mott*, 190 USPQ 536,541 (CCPA 1976)

The response of March 23, 2009 stated that the provisional rejection was premature but when there is an indication of allowable subject matter, appropriate action will be taken. This response takes into account the dicta from *In re Mott* as well as the provisions of MPEP §804 which direct the Examiner to wait until a patent issues before actually issuing a double patenting rejection. Under MPEP§804(B)(2), when same invention double patenting is the only issue remaining in one of two applications containing conflicting claims, the examiner is directed to permit that application to issue and then

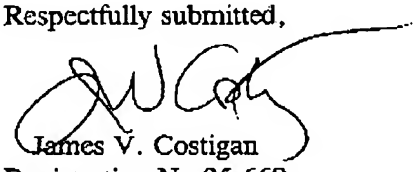
issue a double patenting rejection which would necessitate the type of response contemplated by 37 CFR§1.111(b).

Since the present double patenting rejection is a provisional rejection between two applications, it is believed that the applicant may wait until one application is granted as a patent before deciding to amend, abandon or disclaim. It is not believed that such action is required to be taken in response to a provisional double patenting rejection.

A diligent review of the authorities has been made in search of precedent that supports the Examiner's action in holding the Amendment of July 17, 2009 partially non-responsive on the basis of the response to the provisional double patenting rejection and none has been found. The applicant wishes to advance prosecution without taking any action that may be prejudicial to its rights when no such action is required.

For these reasons, it is requested that the response filed July 17, 2009 be accepted as being responsive to the Office Action of February 17, 2009.

Respectfully submitted,



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